

## **REMARKS**

### **Claim Rejections – 35 USC §103**

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Claims 63-216 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,033,438 to Bianchi et al. in view of U.S. Patent No. 6,258,125 to Paul et al.

### **Declaration of Prior Invention in the United States Under 37 C.F.R. §1.131**

The Applicant submits herewith a Declaration of Prior Invention in the United States under 37 C.F.R. §1.131 to remove the '125 patent as prior art. The '125 patent application was filed on July 30, 1999, and claims the benefit of U.S. Provisional Patent Application Serial No. 60/095,209 filed August 3, 1998. Accordingly, the '125 patent has a purported effective filing date of August 3, 1998. The Applicant reserves the right to challenge the purported effective filing date of the '125 patent.

The Declaration has been signed by each of the joint inventors and indicates that on a date prior to August 3, 1998, the Invention was conceived of and reduced to practice in the United States. To evidence conception and reduction to practice of the Invention, attached to the Declaration is an Invention Disclosure including drawings and a description of the Invention which correspond to the subject matter disclosed and claimed in the subject patent application. The dates listed on the Invention Disclosure have been blacked out, as well as dimensional data associated with the Invention. However, the joint inventors have declared that the "Date of Conception" and the "Date Constructed" occurred prior to August 3, 1998.

The Declaration also indicates that on a date prior to August 3, 1998 and shortly after the Invention was reduced to practice, the Invention was tested in the United States. The joint inventors have declared that the "Date First Tested" listed on the Invention Disclosure occurred prior to August 3, 1998. Following construction and testing of the Invention, the Invention Disclosure was forwarded to the law firm of Woodard, Emhardt, Naughton, Moriarity & McNett for preparation of a patent application. A patent application disclosing and claiming the Invention was filed with the U.S. Patent and Trademark Office on October 28, 1998. (U.S. Patent Application Serial No. 09/181,353; issued as U.S. Patent No. 6,174,311). The subject patent application claims priority to the parent patent application filed on October 28, 1998.

The Applicant submits that the attached Declaration submitted under 37 C.F.R. §1.131 is effective to remove the '125 patent as prior art to the subject application. Accordingly, the Applicant respectfully requests withdrawal of the rejection of claims 63-216 under 35 U.S.C. §103(a) as being unpatentable over the '438 patent in view of the '125 patent. Since the '125 patent has been removed as prior art to the subject application, each of the rejections set forth in the Office Action has been obviated. However, the Applicant reserves the right to refute the claim rejections set forth in the Office Action should the Declaration for any reason be deemed ineffective to remove the '125 patent as prior art.

The Applicant further submits that many of the claims which have been rejected in the Office Action are patentable over the cited patent references for at least the following reasons. For example, and without limitation, independent claims 63 and 82 each recite the "interior side forming a corner with said generally straight portion of said leading end". The Applicant submits that neither the '125 patent nor the '438 patent discloses this feature along with the other recited features of independent claims 63 and 82.

Additionally, claim 65 recites that "at least a portion of said leading end has a reduced height to facilitate insertion of said implant between the two adjacent vertebral bodies." Claims 87, 111, 135, 157, and 181 also recite this feature. However, the implant 10 disclosed in the '125 patent includes a leading end 26 having an increased height relative to the trailing end 28, and thereby fails to disclose the feature recited in each of claims 65, 87, 111, 135, 157 and 181. Moreover, even assuming arguendo that the '438 patent discloses an implant having a leading end with a reduced height, the '438 patent does not disclose that the reduced height leading end has "a generally straight portion from side to side", or that the leading end is "asymmetrical from side to side", as recited in the independent claims from which claims 65, 87, 111, 135, 157 and 181 depend.

Claim 70 recites that "said interior and said exterior sides are at least in part generally parallel one another." Claims 118, 140, 162, and 188 recite similar subject matter. Furthermore, claims 138 and 160 recite that "said interior side is at least in part straight", while claims 139 and 161 recite that "said interior side is at least in part oriented generally parallel to the mid-longitudinal axis of said implant." However, the interior side of the implant 500 disclosed in the '438 patent includes a chamber 530 formed by an arcuate or

curved section, while the interior side of the implant 70 includes a cylindrical space 72. Therefore, the interior and exterior sides of the implants 70 and 500 cannot be at least in part generally parallel to one another. Moreover, the interior sides are not at least in part straight and are not at least in part oriented generally parallel to a mid-longitudinal axis.

Claim 94 recites that “said upper and lower surfaces include at least one opening in communication with one another to permit for the growth of bone from vertebral body to vertebral body through said implant.” Claims 120, 164, and 190 each recite a similar feature. Even assuming arguendo that the ‘125 and ‘438 patents disclose an implant including an opening in the form of the cylindrical space 72 and the chamber 530, the Applicant submits that these features are formed by the interior side of the respective implants 70 and 500, and therefore the upper and lower surfaces cannot include at least one opening. Consequently, the features set forth in claims 94, 120, 164 and 190 are not disclosed in the cited references.

## CONCLUSION

The Applicant respectfully requests entry of this Amendment and consideration of the subject application including pending claims 63-216. A positive indication with regard to the patentability of claims 63-216 is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

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